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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/006,346 | 12/03/2001 | Harry A. Glorikian | P696C1 | 4095 |
| 24739 | 7590 | 10/19/2004 | EXAMINER | |
| CENTRAL COAST PATENT AGENCY PO BOX 187 AROMAS, CA 95004 | | | | CARDONE, JASON D |
| ART UNIT | | PAPER NUMBER | | |
| | | 2145 | | |

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|------------------------|---------------------|
| | 10/006,346 | GLORIKIAN, HARRY A. |
| Examiner | Art Unit | |
| Jason D Cardone | 2145 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 July 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 8-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 8-25 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 December 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment of the applicant, filed on 7/19/04.

Claims 8-25 are presented for further examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 17 are objected to and rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The newly amended independent claims add limitations, from the specification, which are not enabled. The examiner does not understand and cannot find, within the specification, where "types of sessions", "tours planned and taken" and "purchase history" are enabled. The specification does not disclose what are "types of sessions", "tours planned and taken" and "purchase history".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 9, 11-18 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikkola et al. ("Mikkola"), USPN 6,529,143, in view of Gossman et al. ("Gossman"), USPN 6, 317,594.

6. Regarding claim 8, Mikkola discloses an information system for delivering position-related information to a portable digital appliance, comprising: a tracking system for tracking position of the appliance and change of position of the appliance relative to time [ie. position of the mobile device and the speed of movement (change of position relative to time) of the mobile device, Mikkola, col. 4, lines 25-59, col. 8, lines 5-24 and col. 10, lines 6-31];

a data repository comprising data entities identified by one or both of position within one or more bounded regions and change of position of the appliance relative to time [ie. position of vicinity and the movement of the mobile device, Mikkola, col. 7, line 39 – col. 8, line 24 and col. 10, lines 6-31]; and wherein the information system selects information to be provided to the appliance according to the position of the appliance, change of position of the appliance relative to time, and user preference [ie. position, direction of movement, and the interest of the user to the POI (point of interest), Mikkola, col. 7, line 39 – col. 8, line 24 and col. 9, lines 37-63].

Mikkola discloses retrieving POI in accordance to the interest of the user, Mikkola, col. 4, lines 25-59]. Mikkola does not specifically disclose a client profile recording specific preferences for a user of the digital appliance and storing a record of one or more of a history of on-line sessions by the user, types of sessions, tours

planned and taken and purchase history. However, Grossman, in the same field of endeavor, discloses a client profile recording specific preferences for a user of a digital appliance and storing a record of one or more of a history of on-line sessions by the user, types of sessions, tours planned and taken and purchase history [ie. user profile showing credit card balances and transactions, user profile showing tours pre-identified and tours of restaurants taken, Grossman, col. 9, line 51 – col. 10, line 21, col. 23, line 32 – col. 24, line 32 and col. 25, lines 50-64]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a profile with user preferences, taught by Gossman, into the location server system, taught by Mikkola, in order to provide personalized services to individual subscribers when at home or away from home.

7. Regarding claim 9, Mikkola further discloses the position of the appliance is a geographic position on the surface of the Earth [ie. GPS unit, Mikkola, col. 1, lines 13-17 and col. 9, lines 37-63].

8. Regarding claim 11, Mikkola further discloses information retrieved and provided to the appliance is information associated with specific geographic positions, and is selected, at least in part, by the direction of movement of the appliance relative to one of the specific geographic positions [Mikkola, col. 8, lines 5-24].

9. Regarding claims 12 and 13, Mikkola further discloses the information system communicates with the digital appliance on a wireless link, wherein the wireless link is a two-way link, the appliance sends periodic requests for information to the information system [Mikkola, col. 6, lines 44-58, col. 7, lines 6-16 and col. 9, lines 37-63].

10. Regarding claim 14, Mikkola further discloses the periodic requests are automatically-generated [ie. the terminal, itself, sends requests for updates of POI, Mikkola, col. 12, lines 25-51].

11. Regarding claim 15, Mikkola further discloses the periodic requests are manually generated by a user of the appliance [ie. a user may manually request POI information, Mikkola, col. 9, lines 37-50 and col. 12, lines 43-51].

12. Regarding claim 16, Mikkola further discloses information is pushed to the appliance on a pre-arranged time period [Mikkola, col. 12, lines 1-24].

13. Regarding claims 17, 18 and 20-25, they are method claims that generally correspond to the apparatus in claims 8, 9 and 11-16, respectively. Therefore, the similar limitations are disclosed under Mikkola-Grossman for the same reasons set forth in the rejection of claims 8, 9 and 11-16 [Supra 8, 9 and 11-16].

14. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mikkola-Grossman as applied to claims 8 and 17 above, and further in view of Tso et al. ("Tso"), USPN 6,047,327.

15. Regarding claim 10, Mikkola-Grossman further discloses the data repository stores data identified by sub-regions, and position of the appliance within a sub-region is used to select information to be provided to the appliance [ie. position of the POI, Mikkola, col. 7, lines 45-61]. Mikkola-Grossman does not specifically disclose the data repository stores data identified by geographic regions and sub-regions within those bounded regions. However, Tso, in the same field of mobile information retrieval endeavor, discloses breaking up data by region, ie. map of California, (geographic region) and territory the client is currently located, ie regional map of California (bounded sub-region within the geographic region) [Tso, col. 11, line 65 – col. 12, line 25 and col. 19, line 60 – col. 20, line 8]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate more regional levels, disclosed by Tso, for the data storage, disclosed by Mikkola-Grossman, in order better focus the information sent to the user.

Response to Arguments

16. Applicant's arguments with respect to claims 8-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

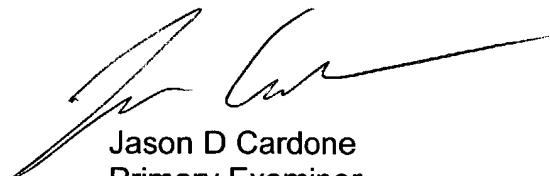
17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone
Primary Examiner
Art Unit 2145

October 15, 2004